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1625

In re application of J. P. ROCHER et al.

Attorney Docket No. P19428  
Mail Stop Non-fee

Serial No. : 09/530,580

Group Art Unit: 1625

Filed : November 4, 1998

Examiner: Unknown

For : NOVEL ALKYLAMINO DERIVATIVES

**Mail Stop Non-Fee**

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

A Request for Extension of Time.

No additional fee is required.

Published Applications Database Search Results.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 19	*20	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 1	**3	0	x 43=	\$	x 86=	\$0.00
Multiple Dependent Claims Presented			+145=	\$	+290=	\$0.00
Extension Fees for Month				\$		\$0.00
			Total:	\$	Total:	\$0.00

\*If less than 20, write 20

\*\*If less than 3, write 3

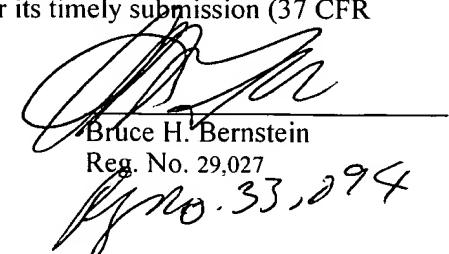
Please charge my Deposit Account No. 19-0089 in the amount of \$\_\_\_\_\_.

N/A A Check in the amount of \$\_\_\_\_\_ to cover the \*filing/extension\* fee is included.

The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

Any additional filing fees required under 37 C.F.R. 1.16.

Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)



Bruce H. Bernstein  
Reg. No. 29,027  
File No. 33,294



P19428.A11

Application No. 09/530,580

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Jean-Philippe ROCHER, et al.

Group Art Unit No. : 1625

Appl. No.: 09/530,580

Examiner: Robinson

I.A. Filed: November 4, 1998

For: NOVEL ALKYLAMINO DERIVATIVES

**ELECTION WITH TRAVERSE**

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the requirement for restriction under 35 U.S.C. 121 and 372 mailed from the U.S. Patent and Trademark Office on January 2, 2004, which sets a one month shortened statutory period for response until February 2, 2004.

Applicants note that this response is being filed prior to the expiration of the one month shortened statutory period for response, whereby an extension of time should not be necessary to maintain the pendency of the application. However, if any extensions of time are required to maintain the pendency of this application, this is an express request for any required extension of time, and authorization to charge any required fee to Deposit Account No. 19-0089.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks which follow:

## RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121 and 372:

I. Claims 1-19, drawn to the compound of formula I where R1 and R2 are H, Alkyl, alkenyl group, hydroxyalkyl group, cycloalkyl group, Z is where R4 and R5 are H, or alkyl group, B represents where D is S or O and R6 and R7 are all groups claimed, Q is -C(O), -C(=NOH)-, X is a monocyclic, polycyclic cycloalkyl group which may be substituted with an alkyl groups, classified in class 546, subclass 198.

II. Claims 1-19, drawn to the compound of formula I where R1 and R2 are H, Alkyl, alkenyl group, hydroxyalkyl group, cycloalkyl group, Z is where R4 and R5 are H, or alkyl group, B represents where D is S or O and R6 and R7 are all groups claimed, Q is -C(O), -C(=NOH)-, X is 1, 2, 3, 4-tetrahydroisoquinoline, classified in class 546, subclass 198.

III. Claims 1-19, drawn to the compound of formula I where R1 and R2 are H, Alkyl, alkenyl group, hydroxyalkyl group, cycloalkyl group, Z is where R4 and R5 are H, or alkyl group, B represents where D is S or O and R6 and R7 are all groups claimed, Q is -C(O), -C(=NOH)-, X is benzoisothiazole or benzoisooxazole, classified in class 546, subclass 198.

IV. Claims 1-19, drawn to the compound of formula I where R1 and R2 are H, Alkyl, alkenyl group, hydroxyalkyl group, cycloalkyl group, Z is where R4 and R5 are H, or alkyl group, B represents where D is S or O and R6 and R7 are all groups claimed, Q is -C(O), -C(=NOH)-, X is benzoisothiazole or benzoisooxazole, classified in class 548, subclass 178.

V. Claims 1-19, drawn to the compound of formula I where R1 and R2 are H, Alkyl, alkenyl group, hydroxyalkyl group, cycloalkyl group, Z is where R4 and R5 are H, or alkyl group, B represents where D is NR8 where R8 is as claimed and R6 and R7 are all groups claimed, Q is -C(O), -C(=NOH)-, X is benzoisothiazole or benzoisooxazole, classified in class 548, subclass 178.

The Examiner asserts that the inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because the species lack a common core.

## ELECTION

In order to be responsive to the requirement for restriction, Applicant elects Group I, i.e., Claims 1-19, drawn to the compound of formula I where R1 and R2 are H, alkyl, alkenyl group, hydroxyalkyl group, cycloalkyl group, Z is where R4 and R5 are H, or alkyl group, B represents where D is S or O and R6 and R7 are all groups claimed, Q is -C(O), -C(=NOH)-, X is a monocyclic, polycyclic cycloalkyl group which may be substituted with an alkyl groups, with traverse. Applicants note that the requirement specifically indicates that all of claims 1-19 are generic, and that this group includes claims 1-19. Therefore, examination of claims 1-19 is appropriate.

For the reasons set forth below, Applicants respectfully submit that the restriction requirement is unclear and improper, and should be withdrawn or, at a minimum, restated and clarified, whereby an action on the merits of all of the pending claims is warranted.

**TRAVERSE**

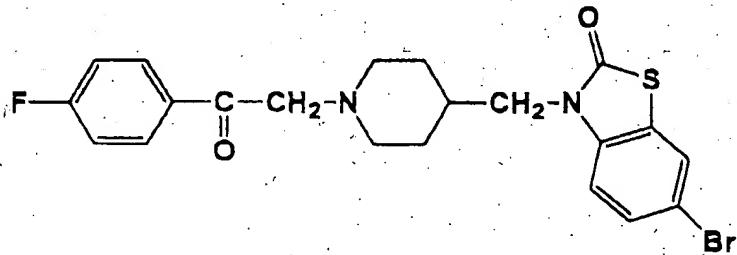
Notwithstanding the election of the claims of Group I in order to be responsive to the requirement for restriction, Applicants respectfully traverse the requirement.

Initially, Applicants respectfully submit that the restriction requirement is without sufficient basis to enable an intelligent election. In particular, the restriction is structured in such as manner that it omits sufficient details and description of formula I, as well as the other formulas recited in the claims, to permit Applicants to elect based upon the criteria set forth in the requirement. For example, groups III and IV appear to be identical.

Still further, for example, the groups apparently fail to include many compounds that are included in claim 1. For example, the groups do not include wherein X is an aryl group, or a heteroaryl group; and X is too narrowly limited where D is NR<sup>8</sup> in Group V.

Still further, for example, the groups do not include R<sup>3</sup> and compounds of Z including R<sup>3</sup>.

Still further, the groups do not appear to include a species that Applicants would like to include as an elected compound, i.e., a compound wherein X is para-fluorophenyl, Q is carbonyl group (-CO-), R<sup>4</sup> is hydrogen, D is oxo group (=O), R<sup>6</sup> is hydrogen, and R<sup>7</sup> is a bromine in the 6-position, as noted below:



Accordingly, the requirement is improper for yet this additional reason.

Applicants have attempted to contact the Examiner as well as the Examiner's supervisor by telephone to discuss this restriction requirement. However, Applicants have not been able to reach these individuals by the initial due date for response. Therefore, Applicants are filing this election to be responsive to the requirement; however, Applicants respectfully request that the requirement be clarified in order to afford Applicants an opportunity to make an intelligent election based upon a requirement that includes clearly delineated groups, and groups that include all of Applicants' compounds.

Yet further, the requirement is without sufficient basis, because it asserts that the species lack a common core. However, the claims include a common core, because in claim 1, line 1, the compound is recited to having the following formula (I) of  $X-C-C(R^1)(R^2)-Z$ , and a salt thereof, and a hydrate thereof and a solvate thereof. Certainly, this is a common core for Applicants' disclosed and claimed compounds.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application. In any event, if the restriction is to be maintained, a new requirement should be mailed which clearly identifies the groups of invention, and includes all of Applicants' disclosed and claimed compounds.

**CONCLUSION**

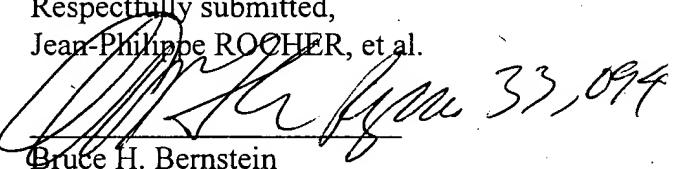
For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper because unity of invention is present, and the requirement should be withdrawn.

Withdrawal of the requirement for the restriction with examination of all pending claims is respectfully requested.

Favorable consideration with early allowance of the application is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, the Examiner is requested to call the undersigned at the telephone number indicated below.

Respectfully submitted,  
Jean-Philippe ROCHER, et al.

  
Bruce H. Bernstein  
Reg. No. 29,027

February 2, 2004  
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